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payment card account being independent of the first payment card account and usable by a second person, having a name different than the name of the first person, without issuing and providing a physical card for the second payment card account of the second type to the second person at a time of, or prior to, the second person uses their second payment card account of the second type in a purchase transaction with a merchant unrelated to an issuer entity for the second payment card account.

41. The method of claim 5 wherein b) occurs at substantially the same time as c).
42. The method of claim 5 wherein c) occurs before an indication is received that b) is complete.
43. The method of claim 5 wherein a), b) and c) occur in sequence.

REMARKS

This Amendment and Response is filed in response to the Office Action Mailed April 30, 2002. Claims 1-43 are currently pending. Claims 1-43 have been rejected under 35 U.S.C §103 as obvious in view of various combinations of the following references: Albrecht (US 5,984,180), Van Dusen (US 6,175,823), O'Mahoney (Electronic Payment Systems-'997 Artech House), Picciallo (US 6,044,360) Giftcertificates.com(8/98), Fleming (US 5,953,710), and Sugimori (US 6,047,265).

Claims 1-43 have been amended. A marked up version of the claims is attached in Appendix A. No new matter has been added by these Amendments.

Applicants respectfully requests reconsideration of the above-identified application in view of the above amendments and the following remarks.

Previous Information Disclosure Statements

As a preliminary administrative matter, on February 11, 1999, February 25, 1999, and April 18, 2000, applicants submitted Information Disclosure Statements (IDS) identifying a considerable number of references that applicants wished to have considered by the Patent Office. For the Examiner's convenience copies of each IDS are enclosed herewith. Although this fact has been repeatedly pointed out with the responses filed to date, and copies of those IDS materials including copies of the certificate of mailings, return postcards, and PTO-1449's were resubmitted nearly two years later, on February 15, 2001, applicants have yet to receive back an acknowledgement that the references submitted with the February 11, 1999 and February 25, 1999 IDS's have been considered. Applicants respectfully again request acknowledgement that such references have been considered by returning the initialed PTO-1449 forms with the next communication.

Claim Amendments

As a result of an apparent lingering misunderstanding of the invention evidenced by the current Office Action (despite all the prior correspondence and interviews to date), applicants have amended the claims to make unambiguously clear that the claims are drafted from the perspective of the actions of a single entity. It is respectfully noted that the amendments are neither intended to broaden nor narrow the scope of any claim and, as will be evident, are not made for purposes of, or necessary to, overcome the cited art or for any patentability reason.

Claim Rejections – 35 USC § 103

All pending claims have been rejected as obvious under 35 USC § 103 in view of various combinations of Albrecht, Van Dusen, O'Mahoney, Picciallo, Giftcertificates.com, Fleming, and Sugimori.

It is respectfully submitted that, as demonstrated below, none of the references alone or in

combination remotely teach or suggest the claimed invention. Moreover, even if one could combine the teachings of cited references, there is nothing in the record that would lead one to do so as to achieve the claimed invention.

In order to further assist the Examiner in understanding the claims, applicants respectfully enclose herewith for informative purposes only, a copy of a "DIAGRAM A" and correlation of claim 1 to that diagram entitled, "AMENDED CLAIM 1 CORRELATION TO DIAGRAM 'A'". It is respectfully submitted that DIAGRAM A does not add new matter. Moreover, it should be understood that the correlation is not intended to imply any particular ordering of the method elements other than those necessarily required by the claim (for example the charge account must be purchased before it can be transferred for use. By following the Diagram and Claim 1 the interaction of the various entities with the subject of Claim 1 will be evident. Thus, in paragraph A, the Transfer Instrument Issuer interacts with the Issuing Bank. In paragraphs B and C, the Transfer Instrument Issuer interacts with the first party wishing to gift the charge account to a second party. In paragraph D the Transfer Instrument Issuer interacts with the second party. In paragraph E the Transfer Instrument Issuer activates the account for usage. In paragraph F the Transfer Instrument Issuer interacts with an independent merchant as a result of a purchase being made. In paragraph G the Transfer Instrument Issuer again interacts with the Issuing bank as a result of the usage of the account.

It is respectfully submitted that, to differing degrees, analogous interactions to one or more of those of Claim 1 are present in each of the other independent claims.

Bearing the above in mind, it should be recognized that the original and pending amended claims are all distinguishable from the cited references, taken individually or in combination.

In addition, it is respectfully noted that, in many cases in order to reject the claims, the

Office Action resorts to a combination of five or more references. While it is fully understood that such action is not *per se* improper and that some of the cited references may be legitimately combined, the Office Action identifies no teaching or suggestion that would lead someone to combine all five references in such a manner to achieve the claimed invention, as opposed to the myriad of other combinations that might possibly be achieved from combining those references.

In general the cited references can be considered as essentially four groups.

The first, contains the Van Dusen reference which involves a system in which the merchant who issues the item (i.e. gift certificate or similar instrument) is also the sole location where that instrument is valid. Essentially, the Van Dusen reference involves a merchant is issuing what is analogous to an in-store credit that can be used by someone else, but only at that merchant. Thus, Van Dusen lacks any aspect of universality. Even if the Van Dusen system would allow for use at some other merchant, this could only happen if there is some prior agreement between the two that would ensure that the accepting merchant would get paid by the issuing merchant. Moreover, Van Dusen does not acquire accounts from another entity or even need to do so, because it is working with the debit/credit balances of its own books.

In contrast, in accordance with the claimed invention, the recipient entity can use the account with merchants unknown to the issuer.

The second group involves systems in which the giver and the receiver share a common account attribute like the credit limit or the account itself. The second group includes the Albrecht, Picciallo, Fleming and O'Mahoney references. In other words, in each of these references, there is a direct correlation and fiscal responsibility between the original account and what is used by the second person. In the case of the Albrecht and Picciallo references, the primary account is "on the hook" for purchases made by the secondary account. The O'Mahoney reference is worse, because there is only one account. The "virtual" number

described therein is not a separate account in any fashion since it merely maps to the pertinent account.

In contrast, with the present invention, once the account is purchased the purchaser has no fiscal responsibility at all. The recipient can freely use (or misuse) account without the purchaser having any actual or potential liability.

The third group involves systems which issue and provide a physical card. This group includes the Albrecht and Picciallo references.

The fourth group involves systems which are utilized as an online gift presentation systems. This group includes the Sugimori reference.

In contrast, as argued *ad nauseum* in the previous responses and appeal brief, with the present invention, although the account transferred is of the type for which a physical card is normally issued, no physical card is issued or provided to the second entity before or as of the time of usage. That aspect continues to be lacking from all of the cited references.

Accordingly, it is respectfully submitted that none of the cited references teach or suggest at least one, if not more, of the following aspects present in the independent claims:

- i) an entity acquiring accounts of the type normally associated with a physical card for transfer to a party at the request of another party (claims 1, 5, 22, 30-33, 35, 37-40),
- ii) the doing of i) above without the issuance and provision of a physical card (claims 1, 5, 22, 30-33, 35, 37-40),
- iii) a universality feature inherent in the ability to use the account at merchants with no relationship to the issuer (claims 1, 5, 22, 30-31, 33, 35, 40),
- iv) a separation between the liability of the purchaser and the recipient (claims 1, 5, 22, 30-33, 35),
- v) that the issuer is financially liable and settles the transaction for purchases made

by the recipient (claim 1), and/or

vi) providing a merchant with the ability to obtain authorization for a purchase using the existing credit/debit/charge card authorization infrastructure (claim 1, 5, 22, 30-33, 35).

Finally, it is respectfully noted that claims 1-4, 12, 25 and 28 have been rejected based upon a combination that includes the cited GiftCertificates.com reference. An examination of the reference's copyright dated indicates "1996-2002". The instant application was filed in November 1998. However, the Office Action has made no attempt to demonstrate exactly what aspects of the reference were from the time period that would be prior art as distinguished from later additions. Applicants are unable to make such a determination and it is respectfully noted that it is not their burden to do so. However, if the relied upon material is not prior art, claims 1-4, 12 25 and 28 are all necessarily *per se* allowable since at least one element of each claim will be lacking from the prior art.

In that regard, it is respectfully noted that applicants submitted with their February 11, 1999 IDS a printout from GiftCertificates.com dated 1998 (copy enclosed). That submission indicates that at least as of 1998, GiftCertificates.com merely provided physical merchant-specific gift certificates. Accordingly, applicants respectfully request that the prior art status of the cited and applied GiftCertificates.com reference.

Conclusion

For all of the reasons as stated above, Applicants respectfully submit that the independent claims 1, 5, 22, 30, 31, 32, 33, 35, 37, 38, 39, and 40, as well as the claims directly or indirectly dependent therefrom are all allowable as patentably distinct from the cited references and early favorable allowance in that regard is respectfully solicited.

Respectfully submitted,
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APPENDIX A

(Version With Markings To Show Changes Made)

IN THE CLAIMS:

Please Amend claims 1-43 as follows:

1. A method performed by a transfer instrument issuer comprising:

acquiring a plurality of charge accounts, from an account issuer, of a type normally issued with an associated physically producible card which may be presented as evidence of an existing charge account, the physically producible cards bearing human readable account numbers and expiration dates, the plurality of charge accounts being capable of being gifted to a party, after acquisition;

receiving a request from a first party to gift a charge account to a second party having a name, without both the issuance and provision of a physical card for the charge account to the second party, the first party and the second party being different from each other the charge account being usable in the name of the second party at any merchant, unrelated to the transfer instrument issuer, who is capable of seeking authorization, using an authorization infrastructure, for purchases involving charge accounts for which the physically producible cards are issued, whether or not the physical cards evidencing the accounts are presented by purchasers when a purchase is made;

accepting an account parameter selected by the first party,

informing the second party of the account by sending an e-mail to the second party, the e-mail containing a greeting selected by the first party and directing the second party to perform a specified action in order to cause an activation of the account with the transfer instrument issuer;

activating the account for usage by the second party according to the account parameter;

receiving an indication that the second party has made a purchase from a merchant, unrelated to the transfer instrument issuer entity, using the account; and

undertaking a settling transaction involving the account with the issuing bank after the usage of the account by the second party without involvement of the first party.

2. The method of claim 1 further comprising : [the step of]
providing a purchaser accessible interface via the world wide web through which the first party can present the request to gift the charge account to the second party.

3. The method of claim 1 further comprising : [the step of]
establishing an account for storage of funds usable by the transfer instrument issuer for undertaking a settling transaction with the account issuer for settling an economic transaction associated with one of the plurality of charge accounts.

4. The method of claim 1 wherein the activating [step] further comprises : [the step of]
ensuring that the authorization infrastructure will authorize the purchase from the merchant as long as an account activity parameter is not violated.

5. A method performed by a transfer instrument issuer comprising:
a) receiving a request from a first party for a gift certificate for a second party having a name, the gift certificate being an indication of a charge account, obtained by the transfer instrument issuer from an account issuer different from the transfer instrument issuer, but without both an issuance and provision of a physical card for the charge account or provision of a presentable gift certificate to the second party, the charge account:

- i) being usable solely in the name of the second party;
- ii) having an associated first party selectable account parameter; and
- iii) being capable of having a purchase made using the account authorized

using an authorization infrastructure of a card association associated with an account issuer;

- b) informing the second party of the account; and
- c) activating the account for usage by the second party.

6. The method of claim 5 further comprising : [the step of]

acquiring a plurality of charge accounts from the account issuer and capable of being gifted, after acquisition.

7. The method of claim 5 further comprising : [the step of]

accepting a backing payment from the first party.

8. The method of claim 5 further comprising [the step of]:

receiving a selection of the account parameter from the first party, the selection being one of, a specified value, a maximum credit limit, a delivery date, a start date, an expiration date, a duration, a billing address, a location for funds from which charges by the second party will be paid, a notification method, or a usage notification arrangement.

9. The method of claim 5 wherein the informing [step] further comprises: [the step of] sending an e-mail to the second party.

10. The method of claim 5 wherein the informing [step] further comprises: [the step of] directing the second party to a website associated with transfer instrument issuer to initiate the activating of the charge account indicated by the gift certificate.

11. The method of claim 5 further comprising : [the step of]
allowing the first party to select a greeting to the second party.
12. The method of claim 5 further comprising : [the step of]
sending a thank you notification to the first party from the second party.
13. The method of claim 5 further comprising : [the step of]
requiring the second party to take a specified action with the transfer instrument issuer before performing the activating [step].
14. The method of claim 5 wherein the informing [step] comprises an online portion and an offline portion.
15. The method of claim 13 [14] wherein the online portion comprises at least two parts, one of the parts involving a different medium than another of the parts.
16. The method of claim 5 wherein the receiving [step] further comprises : [the step of]
processing the request using information provided by the first party in an online purchase form.
17. The method of claim 5 further comprising : [the step of]
providing an accessible URL address for facilitating the receiving the selection [step].
18. The method of claim 5 further comprising : [the step of]
providing an accessible URL address for facilitating a response by the second party to the informing [step].

19. The method of claim 5 further comprising : [the step of]
funding a DDA account held by the transfer instrument issuer associated with the
charge account.

20. The method of claim 5 wherein the informing [step] further comprises: [the step
of]
providing an online display for viewing by the second party.

21. The method of claim 5 wherein the charge account is one of a MasterCard or
VISA account and a transaction involving the second party and the charge account is authorized
in the same manner as would be done for a mail order/telephone order purchase transaction
involving MasterCard or VISA accounts for which physical cards have been issued.

22. A method performed by a transfer instrument issuer comprising:

- a) making an instrument, of a purchaser selectable value, available for
purchase online by a first [person] party in a name of a second [person] party, a purchase of
which will result in the transfer instrument issuer maintaining [of] a payment card account
associated with the second [person] party, although no physical card is both issued for the
account and provided to the second [person] party at a time when the second [person] party uses
the payment card account, the payment card account being maintainable by the transfer
instrument issuer so that when an economic transaction with a merchant, other than the transfer
instrument issuer, occurs in accordance with the instrument parameters, the economic transaction
will be authorized using the authorization infrastructure of a card association authorization entity
normally used to authorize transactions involving a physical payment card account; and
- b) invoking a notification procedure in response to the purchase.

23. The method of claim 22 wherein the payment card account is one of:

i) a credit card account obtained from an account issuer different from the transfer instrument issuer whereby an outstanding balance due need not necessarily be paid at the end of a billing period;

ii) a debit card account obtained from an account issuer different from the transfer instrument issuer whereby at the time of the economic transaction with the merchant, an amount for the economic transaction is transferred from the payment card account held by the transfer instrument issuer to the merchant; or

iii) a charge card account obtained from an account issuer different from the transfer instrument issuer whereby an account balance must be paid in full at the end of a billing period

24. The method of claim 23 wherein the invoking [step] is followed by the step of sending an e-mail to the second [person] party.

25. The method of claim 24 further including [the step of] executing a process which will construct a transfer instrument according to a template selected by the first [person] party.

26. The method of claim 23 further comprising [the step of] acting according to a post-purchase criteria.

27. The method of claim 26 wherein the acting [step] includes one of:

a) informing the first [person] party that a use of the payment card account has occurred;

b) informing the first [person] party of when a use of the payment card account has occurred; or

c) identifying the merchant to the first [person] party.

28. The method of claim 23 further comprising [the step of]:

allowing the second [person] party to specify a criterion related to a use of the payment card.

29. The method of claim 23 further comprising [the step of]:

providing redemption instructions to the second [person] party.

30. A method performed by a transfer instrument issuer comprising:

issuing, to a recipient, an online certificate which is linked to a national card account of a plurality of national card accounts obtained by the transfer instrument issuer from an account issuer different from the transfer instrument issuer, without both issuing and providing a physical card for the national card account to the recipient of the online certificate, the online certificate having been purchased by a purchaser, who is not also the recipient, and containing all information necessary for the purchase of at least one of goods or services from any merchant who is capable of processing economic transactions involving one of the plurality of national card accounts for which a physical card has issued, but without presentment of the physical card.

31. A method performed by a transfer instrument issuer of providing for purchase of a gift comprising [the steps of]:

a) assigning a credit card account to a first [party] person at the request of a second [party] person, upon tender by the second [party] person of a request to charge a credit card belonging to the second [party] person in amount at least as great as a maximum credit limit to be available for the first [party] person when a purchase is made by the first [party] person as a

gift of the second [party] person using the credit card account, the credit card account having been obtained by the transfer instrument issuer from an account issuer different from the transfer instrument issuer, the credit card account being independent of any account associated with the credit card belonging to the second person and being usable by the first [party] person in the first [party's] person's name and with no physical card for the credit card account being both issued and provided to the first [party] person at the time:

- i) the purchase is made using the account,
 - ii) an authorization for the purchase is sought by a merchant using the authorization infrastructure, and
 - iii) an approval is received by the merchant over the authorization infrastructure,
- all occur.

32. A gift of credit method performed by a transfer instrument issuer comprising :
[the steps of:]

- a) receiving an online request from a first party to transfer credit, as a gift, to a second party;
- b) charging a credit card belonging to the first party in a first amount;
- c) assigning a credit card account [issued by a bank] to a second party having a credit limit related to the first amount, obtained by the transfer instrument issuer from an issuing bank the credit card account being independent of the credit card belonging to the first party, the credit card account being one of a plurality of credit card accounts of a type wherein:
 - i) physical cards are issued to people named on the accounts,
 - ii) the physical cards are usable to make a purchase on credit of at least one

of goods or services, and

iii) authorization of charges to the accounts are performed using an authorization infrastructure of a card association of which the bank is a member;

d) informing the second party of the credit card account, the credit card account being usable by the second party in the second party's name without any financial liability being borne by the second party as a result of a use of the credit card account, and no physical card for the credit card account being both issued and provided to the second party at the time an authorization for an economic transaction between the second party and a merchant unrelated to the transfer instrument issuer is performed, using the authorization infrastructure, [whereby, when the use of the credit card account occurs the second person will be using credit of the first person.]

33. A method performed by an account issuer comprising:

a) providing a plurality of zero value debit card accounts to a [first party] transfer entity, and assignable to a [second] user party at the request of a [third] requestor party, the accounts being of a type wherein

- i) physical cards are issued to people named on the accounts,
- ii) the physical cards are usable to purchase at least one of goods or services,
- iii) authorization of uses of the accounts are performed using a card

association authorization infrastructure, and

iv) balances in the accounts are debited as a result of the purchase of the at least one of goods or services,
an assignment from the [first party] transfer entity to the [second] user party to occur upon tender by the [third] requestor party of an amount at least as great as a maximum value to be available

when a purchase is made using the account, the account being usable by the second party in the second party's name and no physical card for the account being both issued and provided to the second party at the time an authorization is performed, using the card association authorization infrastructure, as a result of the second party purchasing one of goods or services using the account.

34. The method of claim 33 comprising the further step of:

b) authorizing a purchase transaction involving the [second] user party, a retail merchant independent from the transfer entity and the account.

35. A method performed by an account issuer comprising:

a) providing a plurality of zero balance credit card accounts to a [first party] transfer entity assignable to a [second] user party at the request of a [third] requestor party, the accounts being of a type wherein

i) physical cards are issued to people named on the accounts,
ii) the physical cards are usable to purchase at least one of goods or services on credit, and
iii) authorization of charges to the accounts are performed using a card association authorization infrastructure, and
iv) credit is extended as a result of the purchase of the at least one of goods or services using the accounts unless there is an offsetting balance in the account at the time of posting,

an assignment from the [first party] transfer entity to the [second] user party to occur upon tender by the [third] requestor party of an approval to charge a major credit card of the third party, in an amount at least as great as a maximum credit line to be available for the account when a purchase

is made using the account, the account being usable by the second party in the second party's name and no physical card for the account being both issued and provided to the second party at the time an authorization is performed, using the authorization infrastructure, as a result of the second party purchasing one of goods or services using the account.

36. The method of claim 35 comprising the further step of:

b) noting a clearing transaction for the account as a result of a usage of the account by the [second] user party.

37. A system comprising:

a database having at least one table, and

a processor coupled to the database, the database being configured to, under control of the processor, maintain a record of a payment card account held by a transfer instrument issuer, and registered to a first person at the request of a second person, and for which, at no time at, or before, a time the second person buys from a merchant unrelated to the transfer instrument issuer and pays by referencing the payment card account, no physical card for the payment card account will have been provided to the second person.

38. A system comprising:

an interface to the internet, the interface being correlated to an IP address for a webpage;
and

a processor capable of displaying the webpage to a person connected to the internet, the webpage including a link which, when selected, will connect the person to a server having a communicative relationship with a database, the database being configured to maintain a records of payment card accounts held by a transfer instrument issuer and obtained from an issuer entity

unrelated to the transfer instrument issuer, the accounts being of a type for which a physical card normally is provided to an individual to whom an account is registered, one of the payment card accounts being registerable to a first person at the request of a second person, the payment card account being maintained such that, at the time the second person buys from a merchant unrelated to the transfer instrument issuer and provides payment by referencing the payment card account, no physical card for the payment card account will have been provided to the second person.

39. A transfer instrument comprising:

a processor accessible storage media; and

a database record located on the storage media, the database record including a plurality of fields, the fields being configured for holding data which will allow a person to make a purchase, using a payment card account indicated by the record, as if the payment card account had an associated physically presentable card in a name of the person even though, at or before a time when the payment card account the account is used to make the purchase, no physical card will have been both issued and physically provided to the person, the payment card account being held by a transfer instrument issuer and obtained by the transfer instrument issuer from an issuer entity unrelated to the transfer instrument issuer.

40. A method comprising:

converting a first payment card account of a first type, for which a payment card has issued and been provided to a first person, the first payment card account being usable solely in a name of the first person, into a second payment card account of a second type , the second payment card account being independent of the first payment card account and [,] usable by a second person, having a name different than the name of the first person, without issuing and

providing a physical card for the second payment card account of the second type to the second person at a time of, or prior to, the second person uses their [the] second payment card account of the second type in a purchase transaction with a merchant unrelated to an issuer entity for the second payment card account.

41. The method of claim 5 wherein [step] b) occurs at substantially the same time as [step] c).

42. The method of claim 5 wherein [step] c) occurs before an indication is received that [step] b) is complete.

43. The method of claim 5 wherein [steps] a), b) and c) occur in sequence.